

REMARKS

Claims 5, 12, 13 and 17 are pending (since claims 1 to 4, 6 to 11 and 14 to 16 were previously canceled without prejudice).

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the priority claims and for acknowledging receipt of the certified copies of the priority documents.

Applicants thank the Examiner for accepting the drawings.

Claims 5, 12, 13 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Saunders, U.S. Patent No. 5,987,951, and further in view of Kataoka, U.S. Patent No. 6,000,269, and further in view of Fukushima, U.S. Patent No. 5,950,480.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

It is respectfully submitted that the applied references, whether taken alone or combined, do not disclose or make obvious the claimed subject matter. For example, there is no disclosure or suggestion whatsoever in the Saunders, Kataoka and Fukushima, whether taken alone or considered in combination, of *making a thickness of a circumferential portion of the material thinner than a thickness of a center portion of the material, so as to form the circumferential portion as a thin annular portion, which is to be formed as a peripheral wall of the case, so as to provide an intermediate product*, as provided for in the context of the presently claimed subject matter of claim 5.

In particular, the Saunders reference refers to a case forming method in which a uniform sheet material is processed by the use of a cupping press (52) and the step of cup formation (57). That is, according to Saunders, to form a desired case, at least two steps are necessary, in which a first step is the cupping press step to obtain a cup-shaped work (56) with a relatively shallow-depth and in which a second step is the cup formation step for diameter-reduction operation to obtain a cup-shaped work product (60).

In lines 43 to 45 at column 6 of Saunders, it states that “side wall thickness is more significantly decreased than in the two operations of the first phase.” It clearly follows from the foregoing that Saunders does not disclose or suggest the “making step” for providing an intermediate product of the presently claimed subject matter of claim 5.

The secondary Kataoka reference is not directed to the forming of cup by the use of a sheet material, but to an improved method for forming that prevents damage to the die while also preventing abnormal flow of the material used therein. In particular, Kataoka shows a material in which a thickness of a circumferential portion thinner than a thickness of a center portion. It is plain, however, that the material of Kataoka does not disclose or suggest the intermediate product of the presently claimed subject matter. Accordingly, the secondary Kataoka reference, whether taken alone or combined, does not cure the critical deficiencies of the primary reference.

The tertiary Fukushima reference is not directed to the forming of cup by the use of a sheet material, but to a method for manufacturing shoe for swash plate-type compressor. In particular, Fukushima concerns a material in which a thickness of a circumferential portion thinner than a thickness of a center portion. It is plain, however, that the material of Fukushima does not disclose suggest the intermediate product of the presently claimed subject matter. Accordingly, the tertiary Fukushima reference, whether taken alone or combined, does not cure the critical deficiencies of the primary reference.

Thus, it clearly follows from the foregoing that the applied references do not in any way disclose or suggest the feature of the presently claimed subject matter of claim 5.

Thus, claim 5 is to a method of forming a case by performing the following: preparing a sheet material, making a thickness of a circumferential portion of the material thinner than a thickness of a center portion of the material, so as to form the circumferential portion as a thin annular portion, which is to be formed as a peripheral wall of the case, so as to provide an intermediate product, and forward drawing the intermediate product so that the center portion of the material is formed as a bottom of the case and the thin annular portion is formed as the peripheral wall of the case to simultaneously form the peripheral wall and the bottom of the case.

Accordingly, claim 5 is allowable, as are its dependent claims 12 and 13.

Claim 17 includes features like those of claim 5 and it is therefore allowable for essentially the same reasons.

Still further, as presented, claim 17 is to a method of forming a cup-shaped case having an internal boss by performing the following: preparing a sheet material, making a thickness of a circumferential portion of the material thinner than a thickness of a center portion of the material to form a thin annular portion, which is to be formed as a peripheral wall of the case, so as to provide an intermediate product, and simultaneously stamping-forming a concavity in the center portion of the material, and forward drawing an intermediate product obtained by the stamping-forming to form a cup-shaped case having a bottom that is thicker than a peripheral wall so that the center portion of the material is formed as a bottom of the case and the thin annular portion is formed as the peripheral wall of the case.

It is respectfully submitted that the emphasized features are in no way disclosed or suggested by the applied references, so that claim 17 is allowable

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103

Application Serial No. 10/542,686
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rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 5, 12, 13 and 17 are allowable.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims 5, 12, 13 and 17 are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully Submitted,

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